

REMARKS

Information Disclosure Statement:

Pursuant to the provisions of 37 C.F.R. §§ 1.56 and 1.97-98 of the Rules of Practice in Patent Cases, enclosed herewith are copies of three references and an accompanying form PTO-1449. These references were cited on March 3, 2000 in a corresponding PCT Application. The Examiner is requested to make these references of official record in the Application. The cited references may be material to examination of the Application; however, no representation is made or intended as to the completeness of this list, nor is the inclusion of any reference on this list an admission that it is prior art or pertinent to this Application.

Restriction:

The Applicants thank the Examiner for not canceling the claims of the non-elected species. The Applicants respectfully request that the instructions on page 1 of the response (paper #5) filed on February 4, 2000, to cancel the non-elected claims be ignored, and that those claims be reinstated.

The Applicants note that the language of new claims 44-47 comes from page 16, line 7 of the Specification, which discusses FIG. 5. Consequently, although the Applicants believe these claims refer to the generic part of the invention, at least they are part of the elected invention.

The Applicants respectfully submit that the restriction is not proper because the "species" identified by the Examiner are all related. The detailed description of the invention discusses FIGs. 1-9 as one embodiment. No other embodiment is illustrated. Thus, at the very least, according to MPEP 806.04(b) the "species" identified by the

Examiner are all related as the one embodiment of the invention. As related inventions, the standards set forth in MPEP 806.05-806.05(i) must also be applied in showing these inventions to be distinct in order for the restriction to be proper. Yet, the Applicants respectfully submit, the Examiner has not done this.

Further, the Applicants note that, according to MPEP 806.04(e), "species" refers to different embodiments, not to different groupings of claims, as the Examiner presumably agrees. The Applicants agree that FIG. 5 represents one of three embodiments (see pages 14-16). However, in contrast to the implications of the Examiner's assertions, although most of the claims generically cover this embodiment, the Applicants respectfully submit that none of the claims are specifically limited to this embodiment. The rest of the figures represent aspects of the only embodiment explicitly illustrated. Specifically, the Examiner's three "species," "Species I" (FIGs. 2, 3, 5, 7 and 9), "Species II" (FIG. 4), and "Species III" (FIG. 6) all represent aspects of one embodiment, as disclosed in the Detailed Description on pages 10-32. Consequently, the Applicants respectfully submit that these three alleged "species" are improper because according to MPEP 806.04(e) "species are always specifically different embodiments."

Therefore, the restriction is improper because what the Examiner identified as different "species" are not species but related inventions, which the Examiner has not shown to be otherwise distinct. Additionally, even if they were proper species, since they are related as one embodiment, the Examiner has not complied with MPEP 806.04(b) and MPEP 806.05-MPEP 806.05(i). Consequently, the Applicants respectfully request that this restriction be withdrawn.

Objections to Drawings:

It is unclear why the Examiner cited 37 CFR §1.83 and 37 CFR §1.84(n). Possibly, the Examiner had in mind the second sentence of 37 CFR §1.84(n). However, the Examiner in his explanation of this objection only discusses the need for textual descriptions, which is an issue related to 37 CFR §1.84(o). The Applicants respectfully submit that FIGs. 2 and 5 comply with 37 CFR §1.83 and 37 CFR §1.84(n). Should the Examiner maintain this objection, the Applicants respectfully request an explanation of the relevance of 37 CFR §1.83 and 37 CFR §1.84(n).

The Examiner suggested using the label, "window containing a menu" for element 200. However, window 200 does not necessarily contain a menu. Unlike the Examiner's interpretation of McLaughlin et al. the "window manager" of the Applicants invention is not a menu or a display of a control panel but a part of the operating system. (In the present invention the special window information in the video signal is intentionally camouflaged within the image so as not to be discernible as such to the viewer, in contrast to the displayed control panel of McLaughlin et al. that the Examiner called a "window manager," as will be discussed below.) Further, the legend "window" should be adequate and therefore the addition of more words would be contrary to the requirement that any descriptive explanation in the figures should "contain as few words as possible" 37 CFR §1.84(o).

The Applicants respectfully submit that the Examiner's requirement to add textual legends to FIGs. 2 and 5 appears to be contrary to 37 CFR §1.84(o). The Examiner stated that "descriptive textual" labels are necessary for FIGs. 2 and 5 in order to understand the drawings "without substantial analysis of the detailed description." However, page 11,

lines 11-13 give a clear and concise textual description of the elements of FIG. 2.

Further, page 14, lines 14-18 contain a clear and concise textual description of the elements of FIG. 2. Thus one does not have much to read to get a quick overview of FIGs. 2 and 5.

Additionally, the illustration of FIG. 2 is suggestive of a monitor with a display screen containing a smaller window. Similarly, the illustration of FIG. 5 is suggestive of a display screen containing a window having a border with two control bars and two heavy lines. The heavy lines are suggestive of the appearance of the indistinctive window information. Thus, these elements are illustrated in a manner that facilitates understanding these two figures.

The Specification is well organized, discussing each figure in order. The discussion of each figure starts with a paragraph that identifies that figure within the first sentence. The three lines that give a brief textual description of all the elements of FIG. 2 are the first sentence of the first paragraph discussing this figure. Similarly, the three lines that give a brief textual description of all of the features of FIG. 5 are the second sentence of the first paragraph discussing that figure. Consequently, the brief textual description of the elements is relatively easy to find. Thus, the Applicants respectfully submit that, in keeping with the second sentence of 37 CFR §1.84(n), one can easily find the textual description of all of the features of FIGs. 2 and 5 by quickly glancing through the Specification within only six lines (which are just two sentences), without any extensive analysis of the Specification, contrary to the Examiner's assertions.

The Applicants note that the phrase "as few words as possible" of 37 CFR §1.84(o) implies that when no words are possible as with FIGs. 2 and 5, no textual

descriptive legends should be present. 37 CFR §1.84(o) allows the Examiner to require textual descriptions only “where necessary for understanding the drawings,” (as is often the case with flowcharts and block diagrams). However, in the present case, where (1) the pictorial illustrations are suggestive of what they represent, (2) one can easily and quickly find the description of these figures in the Specification, and (3) one needs only to read two sentences, one sentence for each of FIGs. 2 and 5 to get a brief description of each element, textual descriptive labels are unnecessary for understanding the drawings. Therefore, the Applicants respectfully submit it would be contrary to 37 CFR §1.84(o) to require the addition of textual descriptive labels to FIGs. 2 and 5.

Rejections:

The Applicants note that in all of the rejections the Examiner relied upon McLaughlin et al. as the primary reference. The Examiner apparently would agree that McLaughlin et al. does not actually teach the inventive concept of the Applicants’ disclosure, but apparently rejected the claims over this reference because of their breadth. The Applicants note that the second paragraph of MPEP 707.07(g) requires the Examiner to make the best rejection that relates to the “heart” of the invention (if one exists) rather than any that relate to the “breadth” of the claims. As the inventive concepts of the Applicants’ disclosure appear to be absent from the other references cited, as well, it appears that the Examiner would agree that there is allowable subject matter in this Application, even though the Examiner has not explicitly acknowledged this.

35 USC §102:

The Examiner rejected claims 1, 3, 4, 21, 23, and 24 as anticipated under 35 USC §102(b) over McLaughlin et al., US Patent Number 5,570,108. The Applicants note that the McLaughlin et al. patent never explicitly discusses its video signal. Although inherently there may be some video signal to address the video display, it is by no means inherent that a portion of the video signal is siphoned off to be read by a window decoder, which then generates a display control signal in response to the information embedded in the video signal (by the window manager), as claimed. Thus, even if *arguendo* the window manager of the claims reads on the window with the control buttons displayed on the screen, and even if *arguendo* the window decoder of the claims reads on McLaughlin et al.'s processor, then this "window manager" of McLaughlin et al. does not embed any information into the video signal. Rather, the video signal creates this "window manager" (when it creates the image on the screen). Although there is video information embedded in the display and therefore embedded in the video signal, this signal is never sent back to the processor or "window decoder." Rather the signals from the mouse or other input device, generated by the user, are sent to McLaughlin et al.'s processor or "window decoder." The signal from the mouse or input device (and not the signal from the display the Examiner interpreted as the "window manager") creates the information that is decoded by the processor to responsively generate a display control signal (see, for example, column 6, lines 10-19). Further, the Applicants respectfully submit that the Examiner's interpretation of the term "window manager" of the claim is tenuous at best because the control buttons on the screen are just a display that manage and control nothing.

The Applicants also note that although the colorimeter measures the output of the phosphors, it merely calibrates the output of the processor by comparing the measured output of the phosphors to the desired output. The signal from the phosphors is not a video signal. Inherent in the operation of the colorimeter is the use of the difference between the signal from the phosphors and the desired output rather than the actual output of the phosphors to change the display. Effectively, the colorimeter throws away any window information by not actually using it to change the output of the processor, but instead using the difference between the actual and desired output from the phosphorus to do its calibration. Further, a video signal is what is used to stimulate the phosphors and the output of the phosphors does not read on the claimed video signal. Additionally, claim 1 contains the clause “a window manager to embed special window information in a video signal.” According to the plain meaning of this clause, the purpose of the window manager is to embed special window information in the video signal. The purpose of the icons of the color pre-proofing display in FIG. 2 of McLaughlin et al. is not the generation of the signal taken from the phosphors, even though a signal might be generated from those phosphors. One is more likely to use the signal of phosphors in window 300 for performing the calibration rather than those of the icons of FIG. 2 of McLaughlin et al. because the image in window 300 has a closer correspondence to the image the user is trying to produce. Calibrator 19 is in the center of the screen in FIG. 10, while in FIG. 11 the display of the control buttons, which the Examiner interprets as a window manager, is at the bottom of the screen. Thus, the signal picked up by the calibrator is not from the “window manager” but from phosphors in the center of the screen.

As for claims 3 and 23, the Examiner interpreted the processor of McLaughlin et al. as the window decoder. The McLaughlin et al. patent never uses the phrase “application specific integrated circuit” or its acronym “ASIC.” The McLaughlin et al. patent never gives any details of the circuitry of their processor 11, in FIG. 1 or any other figure. Contrary to the Examiner’s assertions, McLaughlin et al.’s reference to the “programmed processor 11,” (in column 6, lines 57-61) implies that processor 11 needs to be programmed and is therefore not application specific. Consequently, even accepting the Examiner’s interpretation of claims 1 and 21 *arguendo*, a rejection under 35 USC §102 of claims 3 and 24 is improper.

As for new claims 44-47, in the McLaughlin et al. patent the user should be able to easily see the display of the window control buttons, which the Examiner interpreted as a “window manager.” Thus, to make the part of this display containing the video information “indistinctive,” as recited in these new claims runs counter to the teachings of McLaughlin et al. Consequently, even accepting the Examiner’s interpretation of claims 1 and 21 *arguendo*, claims 44-47 are not anticipated and are not obvious.

35 USC §103

None of the references cited by the Examiner cures the deficiencies in McLaughlin et al. with regard the independent claims 1, 21, 42 and 43. Therefore, all of the rest of the claims under consideration are allowable because they depend on one of claims 1 and 21. Additionally the combinations of references proposed by the Examiner do not fully teach the subject matter alleged by the Examiner.

The Examiner used Fisher for a teaching of the use of an operating system, and contended that it reads on the claimed "window manager" but also stated

Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin (pat. # 5,570,108) as applied to claim 4 above, and further in view of Fisher (pat. 5,903,267).

However, in the rejection of claim 1 from which claim 4 depends the Examiner stated

McLaughlin teaches a window which can also be interpreted as the presence of a corresponding window manager

If the window of McLaughlin et al. is the window manager for purposes of rejecting claims 1 and 4, and if McLaughlin et al. is being used "as applied to claim 4," then how can the operating system of Fisher also be the window manager of the claims? The Applicants respectfully request clarification of this point.

Further, the Examiner stated

It would be obvious ... for the stop [sic] of embedding [to] be performed by a window manager that is included in the operating system to simplify application software development because doing so allows software writers to dedicate their time [to] performing only those tasks which involve customization.

However, although the Examiner provided a motivation for making his proposed modification to McLaughlin et al., the motivation did not come from either McLaughlin et al. or Fisher. Rather it came from the Applicants' Specification (see for example the last sentence of page 12). Consequently, the Examiner used hindsight, which is impermissible in constructing a rejection under 35 USC §103 (see MPEP 2145 X A, which cites *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)).

Claims 5-10, 12, 25-30, 32 and 41-43 were rejected under 35 USC §103 over McLaughlin et al. as applied to claim 4, in view of Shafer et al. There is no teaching or suggestion in the prior art to use the time display of Shafer et al. simultaneously with the

calibration features of McLaughlin et al. The calibration features would only be used on occasion, such as when first setting up the TV, because, once set, the calibration should hold for a while. (It would be annoying to watch TV with the calorimeter in the middle of the screen as shown in FIG. 10 of McLaughlin et al.) The prior art time display of Shafer et al. is to alert someone that the TV is about to shut off without waking them if they are falling asleep. This would typically occur towards the end of watching TV. The Examiner has not shown a motivation that would suggest a person calibrating the color of their TV either while asleep or while worried about resetting the timer before the TV shut off because they are not yet as sleepy as they had hoped to be and still want to watch TV, for example. Thus, even if the combination of McLaughlin et al. and Shafer et al. suggested placing a first color signal to serve as a clock in the same display that has the special window information produced by a window manager, there is no suggestion to use the two together, as required in the claims. As a further elaboration of this point, the claims in question require cooperation between the “special window information” and the “video clock signal.” Specifically, these claims require “a first color signal serving as a video clock signal for special window information.” It is difficult to see how this sort of cooperation could be suggested between two unrelated elements that appear in two different unrelated references. Therefore, it is difficult to see how the combination of these two references teaches “a first color signal serving as a video clock signal for special window information.”

Claims 42 and 43 were first rejected under 35 USC §103 “as being unpatentable over McLaughlin ... as applied to claim 4 above, and further in view of Shafer” in the rejection of claims 5-10, 12, 25-30, 32 and 41-43, referred to above. In contrast, the

explanation given by the Examiner for claim 42 is “McLaughlin in view of Shafer teach the rationale of claim 42 in rejected claim 21.” Similarly, the explanation given by the Examiner for rejecting claim 43 is “McLaughlin in view of Shafer teach the rationale of claim 43 in rejected claim 21.” However, the Examiner never applied McLaughlin et al. in view of Shafer et al. to claim 21. Rather, McLaughlin et al. was applied alone in a rejection under 35 USC §102. However, the McLaughlin et al. reference falls short of meeting the limitations of claims 42 and 43 for at least the same reasons it falls short of meeting the limitations of claim 21, as discussed above. Shafer et al. does not cure the deficiencies in McLaughlin et al. in meeting the limitations of claims 42 and 43.

Claims 11 and 31 were rejected under 35 USC §103 over McLaughlin et al. as applied to claim 4, in view of Shafer et al. and further in view of Priem. Contrary to the Examiner’s assertions, although Priem has a window E, which is depicted as an oval, the Applicants respectfully submit that the Examiner has not shown any evidence of a motivation to combine the references. Although the Examiner gives a reason to include the non-rectangular window within McLaughlin et al.’s display, the reason given by the Examiner is not found in any of the references cited. Priem does not teach how to make his non-rectangular window. Consequently, Priem does not teach the use of a “shape sequence” which is used to indicate the shape only if the shape is not rectangular, as required by claims 11 and 31. Thus, the Examiner’s proposed combination, even were it obvious, would not result in the claimed invention, including all of the limitations of dependent claims 11 and 31.

SUMMARY

The restriction should be withdrawn because the groupings identified by the Examiner are related to one another and are not separate species.

The Examiner's objection to the drawings should be withdrawn because the drawings can easily be understood, without extensive analysis of the Specification.

The rejection of claims 1, 3, 4, 21, 23, and 24 over McLaughlin et al. under 35 USC §102 should be withdrawn because the alleged window manager of McLaughlin et al. never sends any signal to a window decoder, as claimed.

The rejections under 35 USC §103 should be withdrawn because none of the references cited cure the deficiencies of McLaughlin et al. in meeting the limitations of the independent claims 1, 21, 42 and 43.

Further, the only rationale given by the Examiner for combining Fisher with McLaughlin et al. comes from the Applicants' Specification and is therefore hindsight.

The Examiner has not given any motivation for the combination of McLaughlin et al. with Shafer et al. This proposed combination fails to teach the cooperation necessary for a "color signal" of Shafer et al.'s prior art to clock the "special window information" of McLaughlin et al., as claimed, even accepting the Examiner's interpretation of these references.

Priem does not teach the "shape sequence" of claims 11 and 31.

New claims 44-47, in addition to depending upon allowable claims 1, 21, 42 and 43, require the embedded special window information to be indistinct, in sharp contrast to the teachings of any of the references cited.

Therefore, the Applicants respectfully request the Examiner to withdraw the objection to the drawings, the restriction, and rejections under 35 USC §102 and §103 and allow this Application.

Respectfully submitted,

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